

REMARKS/ARGUMENTS

I. Status of the Claims

Claims 1-41 are pending. Claims 1-41 are currently presented. Claim 34 has been amended to correct a typographical error.

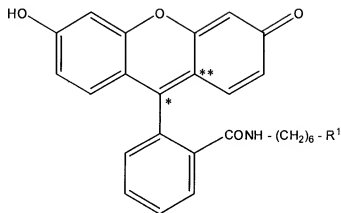
The Examiner has withdrawn claims 2-17, 24-28 and 41 under 37 CFR 1.142(b) as being drawn to a nonelected invention or species. Applicants note that the Examiner has made no requirement for restriction or election during the pendency of the instant application. Thus, no election of invention or species is currently of record, and it is therefore improper for the Examiner to withdraw 2-17, 24-28 and 41. Applicants request that the Examiner rejoin the withdrawn claims.

II. Claims Rejected 35 USC § 102

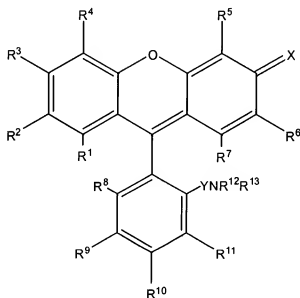
To maintain a *prima facie* case of anticipation, the Examiner must demonstrate that each and every element as set forth in the claim is either expressly found or is inherently described in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ...claim. See MPEP § 2131. Applicants submit that each element of the claims now pending has not been identified in the art presently of record. Therefore, Applicants respectfully traverse the following rejection.

Over Glombik et al. (US Patent No. 5,610,151)

The Examiner has rejected claim 1 under 35 USC § 102(b) as allegedly being anticipated by US Patent No. 5,610,151 to Glombik et al. ("Glombik"). The Examiner asserts that Glombik in column 28, example 55, (Formula I below) teaches a xanthene dye according to claim 1, wherein the carrier molecule of R¹² or R¹³ is a bile acid. In Formula I, Applicants have inserted a double bond between the carbons marked * and ** to correct for an assumed misprint in the original patent. Claim 1 recites a xanthene dye according to Formula II below.



(I) (Glombik)

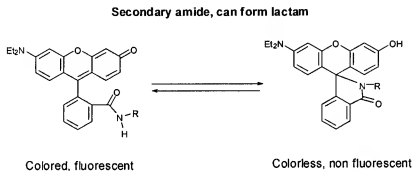


(II) (Applicants)

Glombik does not disclose the xanthene dye of claim 1. As shown above in Formula I, Glombik discloses that the *ortho* moiety on the benzene ring attached to the xanthene residue comprises a secondary amide; that is, the amide nitrogen is bonded to a hydrogen atom. On the other hand, as shown above in Formula II according to Applicants' claimed invention, neither R¹² nor R¹³ according to claim 1, lines 40-50, is a hydrogen atom. In other words, the *ortho*

moiety on the benzene ring attached to the xanthene residue in Formula II comprises a tertiary amide. As such, Glombik does not anticipate claim 1.

Applicants note that the molecule taught by Glombik is not suitable for the purposes of the present invention, which provides for fluorescent labels. The secondary amide in Glombik has a propensity for lactam formation:



A derivatized xanthene molecule containing a lactam ring as shown above is stable and lacks fluorescent properties. Such a product would not work well in the applications for which the compounds and methods of the present invention are suited.

In addition, the teachings of Glombik are in fact quite narrow and only tangentially relevant to the present matter, if at all. Glombik discloses bile acid derivatives for use as medicaments. *Glombik*, abstract. These medicaments function by binding to bile acids to inhibit absorption and are formulated for their high affinity for the specific bile acid transportation system of the small intestine. *See id.* at col. 1, lines 16-19 and col. 3, lines 43-46. Glombik does not teach or disclose any xanthene dye for use as a detectable label.

Out of the many derivatizing moieties taught by Glombik in columns 1-4, only one type of fluorescein moiety is disclosed, and even then, no particular reason is disclosed regarding the moiety's usefulness in the disclosed invention. In any case, the fluorescein moiety of Glombik contains only a secondary amide, which bridges the fluorescein conjugated ring system and the bile acid. No other fluorescein moiety is taught, and hence no fluorescein containing a tertiary amide is anywhere disclosed. Given the subject matter of Glombik and its narrow teaching of one fluorescein moiety containing a secondary amide, one of skill in the art would not consult

Glombik to arrive at the presently claimed invention, which is directed toward detectable fluorescein derivatives containing a tertiary amide group.

Therefore, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1000.

Respectfully submitted,



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